

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Ex parte DAVID T. FREDERICK et al.

Appeal No. 2005-2434  
Application No. 09/086,857

ON BRIEF

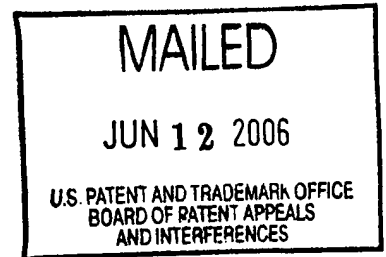
Before FRANKFORT, McQUADE, and GRON, Administrative Patent Judges.

McQuade, Administrative Patent Judge.

REMAND TO THE EXAMINER

David T. Frederick et al. have appealed from the final rejection (mailed May 6, 2004) of claims 1-47, all of the claims pending in the application. Before considering the appeal on its merits, we find it necessary to remand the application to the examiner under the authority of 37 CFR § 41.50(a)(1) for action consistent with the following remarks.

The final rejection contains twenty-four separate rejections, referred to hereinafter as rejections 1-24,



respectively, based on the order in which they appear. Rejection 1 is an indefiniteness rejection under 35 U.S.C. § 112, second paragraph, and rejections 2-24 are prior art rejections under 35 U.S.C. § 102(b), 102(e) or 103(a). The examiner's answer (mailed September 10, 2004) restates rejections 1-24 with a change to rejection 19 correcting an inconsistency noted by the appellants on page 5 in the main brief (filed May 27, 2004).

A review of the prior art rejections shows that the examiner has applied multiple such rejections against many of the appealed claims. By way of example, claim 45 stands rejected on seven separate grounds, claim 46 stands rejected on six separate grounds, each of claims 1, 16, 17, 20, 24 and 47 stands rejected on five separate grounds and each of claims 3, 9, 25 and 44 stands rejected on four separate grounds.

MPEP § 706.02, under the heading "CHOICE OF PRIOR ART; BEST AVAILABLE," states that:

Prior art rejections should ordinarily be confined strictly to the best available art. Exceptions may properly be made, for example, where:

(A) the propriety of a 35 U.S.C. 102 or 103 rejection depends on a particular interpretation of a claim;

(B) a claim is met only in terms by a reference which does not disclose the inventive concept involved; or

(C) the most pertinent reference seems likely to be antedated by a 37 CFR 1.131 affidavit or declaration.

Such rejections should be backed up by the best other art rejections available. Merely cumulative rejections, i.e., those which would clearly fall if the primary rejection were not sustained, should be avoided.

The record in this application does not demonstrate any legitimate reason for the examiner to have entered the large number of prior art rejections that are currently standing against many of the appealed claims. Indeed, the examiner's explanations of the various grounds indicate that the multiple rejections applied against any given claim are merely cumulative. Consequently, on remand the examiner is directed to select the preferred or best prior art rejection for each of the appealed claims for consideration on appeal. See MPEP § 1211.

In choosing the best prior art rejection of each claim, the examiner should consider the following factors and, if need be, take corrective action in accordance with prescribed USPTO practice.

I. The explanations of a number of the prior art rejections mention claims that do not appear in the respective statements of the rejections. These inconsistencies make it unclear whether such claims are intended to be so rejected. The rejections and claims in

question are rejection 2 (claims 42 and 43), rejection 14 (claim 35), rejection 15 (claim 40), rejection 17 (claims 34 and 35), rejection 18 (claims 34 and 35), rejection 21 (claims 34 and 35), rejection 21 (claims 34 and 35), rejection 22 (claim 34) and rejection 23 (claims 11 and 21).

II. Claims 11, 30, 34, 35, 40 and 41 do not appear in the statement of any prior art rejection.<sup>1</sup> This omission, considered in conjunction with the examiner's failure to indicate that these claims contain subject matter allowable over the prior art (as required by MPEP § 707.07(j)), renders the status of the noted claims unclear with regard to patentability over the prior art.

III. The explanations of rejections 7, 13, 21 and 22 rely on one or more references that are not included in the respective statements of the rejections. The use of references in this manner to support a rejection is improper (see In re Hoch, 428 F.2d 1341, 1342 n.3, 166 USPQ 406, 407 n.3 (CCPA 1970); and MPEP § 706.02(j)).

IV. The record contains a 37 CFR § 1.131 Declaration by R. Michael McGrady, the asserted "sole inventor of the

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<sup>1</sup> Claims 30, 34, 35, 40 and 41, but not claim 11, appear in the statement of rejection 1, the 35 U.S.C. § 112, second paragraph, rejection. Claim 11 does not appear in the statement of any rejection.

subject matter described and claimed in claims 24 and 45" (declaration, ¶ 1). The appellants filed the declaration on September 27, 2000 to swear back of certain references cited by the examiner.<sup>2</sup> To accomplish this objective, the declaration purports to establish that "the invention as claimed in each of claims 24 and 45 was completed by being conceived and reduced to practice in this country prior to March 7, 1994" (¶ 5). The examiner has found the declaration sufficient to show such conception and reduction to practice and consequently has withdrawn some rejections (see the advisory action mailed November 7, 2000). A cursory review of the declaration, however, shows that it is not accompanied by (1) any evidence documenting the asserted activities leading to the alleged reduction to practice (see ¶ 4b) or (2) a satisfactory explanation for the absence of such evidence.<sup>3</sup> See 37 CFR § 1.131(b). Hence, the declaration on its face appears to be fatally flawed for the reasons specified in MPEP § 715.07. On remand, the examiner is directed to carefully reassess the

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<sup>2</sup> The declaration supersedes an earlier declaration filed May 23, 2000.

<sup>3</sup> The only evidence submitted with the declaration consists of selected pages of a SelecTrac Functional Specification (Software) document attached as Exhibit A and proffered in conjunction with the declarant's assertion of the conception of the claimed invention (see ¶ 4a). This exhibit does not, and is not asserted to, constitute proof of the alleged activities.

merits of the declaration, make of record the results of the reassessment with supporting cogent reasoning and take appropriate action consistent with the reassessment in choosing the best prior art rejection for each claim.

V. The instant application claims the benefit under 35 U.S.C. § 120 of the earlier filing dates of Application No. 08/927,593, filed September 11, 1997, now Patent No. 5,912,818, granted June 15, 1999, and Application No. 08/361,783, filed December 16, 1994, now Patent No. 5,790,409, granted August 4, 1998. According to the appellants, the instant application is a continuation-in-part of each of these earlier applications. On appeal (see for example pages 25-33 in the main brief), the appellants contend that at least claims 24 and 45 are entitled to the December 16, 1994 filing date of Patent No. 5,790,409. This date antedates certain references and hence would obviate the prior art rejections based thereon. To support their position, the appellants have reproduced claim 45 in the main brief (see pages 26-28) with annotations to the purported supporting portions of Patent No. 5,790,409. From the appellants' perspective, the recitations of the housing and door in claim 45 find support in the patent's disclosure of electronic lock drawer 96 at column 16, lines

11-33. This disclosure, however, gives no apparent indication that the electronic lock drawer 96 includes a door as recited in claims 45 and 24.

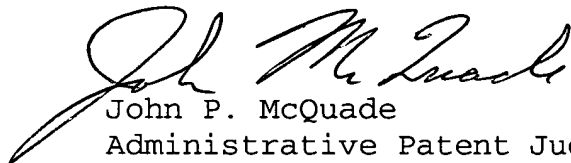
This application, by virtue of its "special" status, requires an immediate action, MPEP § 708.01(D).

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

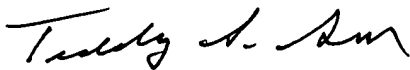
REMANDED



Charles E. Frankfort  
Administrative Patent Judge



John P. McQuade  
Administrative Patent Judge



Teddy S. Gron  
Administrative Patent Judge

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